REMARKS

Claims 1-5, 7-10, 15, and 17-20 were pending in this application.

Claims 1-5, 7-10, 15, and 17-20 have been rejected.

Claims 1, 3-5, 7-10, 15, 17, 19, and 20 have been amended as shown above.

Claims 1-5, 7-10, 15, and 17-20 remain pending in this application.

Reconsideration and full allowance of Claims 1-5, 7-10, 15, and 17-20 are respectfully requested.

I. OBJECTIONS TO THE CLAIMS

The Office Action objects to Claims 1 and 15 because of several informalities noted in the Office Action. The Applicant has amended Claims 1 and 15 to correct the noted informalities. The Applicant respectfully requests withdrawal of the objections.

II. REJECTION UNDER 35 U.S.C. § 103

The Office Action rejects Claims 1, 2, 4, 5, 7-9, 15, 19, and 20 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,991,737 to Chen ("*Chen*") in view of U.S. Patent No. 5,819,034 to Joseph et al. ("*Joseph*"). The Office Action rejects Claims 3 and 10 under 35 U.S.C. § 103(a) as being unpatentable over *Chen* and *Joseph* in further view of U.S. Patent No. 5,991,601 to Anderson ("*Anderson*"). The Office Action rejects Claims 17 and 18 under 35 U.S.C. § 103(a) as being unpatentable over *Chen*, *Joseph*, and *Anderson* in further view of U.S. Patent No. 5,949,492 to Mankovitz ("*Mankovitz*"). These rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (*MPEP § 2142; In re Fritch, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992)*). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. (*MPEP § 2142; In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)*). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. (*MPEP § 2142; In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993)*). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. (*In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); In re Grabiak, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985)*).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993)*). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's

disclosure. (*MPEP § 2142*).

Chen recites an automated system for allowing consumers to purchase products based on publicly broadcast information. (*Col. 1, Lines 45-64*). In particular, a consumer may identify broadcast information (radio, television, billboard, etc.) through which the consumer has learned of a product. (*Col. 4, Lines 9-17*). For example, the consumer may identify a radio station or a television channel. (*Col. 3, Lines 28-43*). Using the identity of the broadcast information, the system of *Chen* allows the consumer to order the product. (*Col. 3, Lines 47-64*).

The Office Action relies on column 5, line 56 through column 6, line 8 of *Chen* as showing that an "item identifier" is transmitted simultaneously with "content information" as recited in Claims 1, 7, and 15. (*Office Action, Page 3, Section 11*). However, this portion of *Chen* fails to disclose, teach, or suggest how the "item identifier" is used as recited in Claims 1, 7, and 15.

The cited portion of *Chen* recites that a transmitter may transmit "RBDS/RDS signals (Radio Broadcast Data Systems / Radio Data Systems protocol)." (*Col. 5, Lines 56-58*). This may allow a consumer's radio to identify the music being played. (*Col. 5, Line 59 – Col. 6, Line 2*).

This portion of *Chen* simply states that information is received and displayed on a radio. This portion of *Chen* lacks any mention of using the information in the "RBDS/RDS signals" in any way except to display the identity of music being played on a consumer's radio. No other use for the "RBDS/RDS signals" is disclosed in *Chen*. In particular, the "RBDS/RDS signals" are not used to place orders for a product.

Because of this, *Chen* fails to disclose, teach, or suggest a "purchase request processor" capable of receiving the "item identifier directly from [a] content access device" and a "purchase

request buffer" capable of "storing at least one purchase request ... and the item identifier to facilitate a purchase of an item corresponding to the item identifier" as recited in Claim 1. Similarly, *Chen* fails to disclose, teach, or suggest a "purchase request buffer" configured to "store at least one purchase request and the item identifier to facilitate a purchase of an item corresponding to the item identifier" as recited in Claim 7. In addition, *Chen* fails to disclose, teach, or suggest "creating" at least one "purchase request" that includes an "identifier" of an item, "storing" the purchase request (which includes the item identifier) for "subsequent purchase of the item," and "communicating" the purchase request (which includes the item identifier) to a "provider of the item" as recited in Claim 15.

Moreover, there is no suggestion or motivation to modify *Chen* so that *Chen* uses an item identifier as recited in Claims 1, 7, and 15. The whole purpose of *Chen* is to provide a system that uses the identity of broadcast information (radio station, television channel, billboard number, etc.) to associate an order for a product with the product. Modifying *Chen* to use item identifiers rather than the identity of broadcast information would render *Chen* inoperable for its intended purpose. As a result, *Chen* cannot be modified to use item identifiers.

The Office Action only relies on *Joseph* as allegedly disclosing a "single click purchase." (*Office Action, Page 6, Sixth paragraph*). The Office Action does not rely on *Joseph* as disclosing, teaching, or suggesting any other elements of Claims 1, 7, and 15.

For these reasons, the Office Action fails to establish that the proposed *Chen–Joseph* combination discloses, teaches, or suggests all elements of Claims 1, 7, and 15 (and their dependent claims). Accordingly, the Applicant respectfully requests withdrawal of the § 103 rejection and full

allowance of Claims 1-5, 7-10, 15, and 17-20.

III. CONCLUSION

The Applicant respectfully asserts that all pending claims in the application are in condition for allowance and respectfully requests an early allowance of such claims.

SUMMARY

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any extension of time fees) or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date: Aug. 31, 2004

William A. Munck
Registration No. 39,308

P.O. Drawer 800889
Dallas, Texas 75380
(972) 628-3600 (main number)
(972) 628-3616 (fax)
E-mail: *wmunck@davismunck.com*